

Serial No. 09/604,835

6

REMARKS

This amendment is intended as a full and complete response to the non-final Action mailed June 5, 2003. In the Action, the Examiner notes that claims 1-14 are pending, of which claims 1-14 stand rejected. By this amendment, claims 1 and 5-7 are amended and claims 2-4 and 8-14 continue unamended.

In view of both the amendments presented above and the following discussion, the applicants submit that none of the claims now pending in the application are non-enabling, anticipated, or obvious under the respective provisions of 35 U.S.C. §102, and §103. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

Objections**A. INFORMATION DISCLOSURE STATEMENT**

The Examiner objected to the information disclosure statements filed on 10/16/00 and 11/07/02 as failing to comply with 37 C.F.R. 1.98(a)(2) which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

In response thereto, Applicants have filed herewith copies of Levine (U.S. Patent No. 5,414,756, issued May 9, 1995) and Yuen et al. (U.S. Patent No. 5,673,089, issued September 30, 1997).

In addition, Applicants agree that the correct citation of Bedard is "U.S. Patent No. 5,801,747, issued September 1, 1998." As such, we have enclosed Form 1449 indicated the proper citation for Bedard.

Serial No. 09/604,835

6

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In view of both the amendments presented above and the following discussion, the applicants submit that none of the claims now pending in the application are non-enabling, anticipated, or obvious under the respective provisions of 35 U.S.C. §102, and §103. Thus, the Applicants believe that all of these claims are now in allowable form.

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Serial No. 09/604,835

7

B. IN THE DRAWINGS

The Examiner has objected to the drawings for "failing to comply with 37 C.F.R. 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: items 711 H of Figure 7." As indicated below, Applicants have amended the specification to add the reference sign(s) in the description.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

The Examiner has rejected claims 1-4 and 6 under 35 U.S.C. 102(b) as being clearly anticipated by Girard et al. U.S. Patent No. 5,751,282 ("Girard"). The Applicants respectfully traverse the rejection.

Girard teaches a system and method for calling video on demand using an electronic programming guide. Specifically,

"A viewer is permitted to scroll through the program grid to list titles of past, current, and future programs. A database, resident at the head end server, supplies the program titles and scheduled viewing times of the past, current, and future programs to the electronic programming guide. The head end server transmits real-time video data streams of the available programs to the EPG. A continuous media server, resident at the head end server, stores the video data streams to build a reserve of previously played programs. The media server can also store video preview clips of future programs. When a viewer selects a current program, the real-time video data stream of the current program is displayed by the set-top box. When the viewer selects a past program, the head end server retrieves a stored video data stream of the selected past program and transmits it to the set-top box. When the viewer selects a future program, the head end server retrieves a stored video preview clip of the future program and transmits it to the set-top box." See Girard Abstract.

Applicants disclose a method for delivering short-time duration video segments to terminals via a communications network. Specifically, Applicants' method transmits a control message from the session manager to a transport stream generator indicating whether a transport stream may be discontinued by the transport stream generator.

Applicants' claim 1 positively recites:

A method for delivering short-time duration video segments to terminals via a communications network, the method comprising:
receiving from a terminal a request for a video segment corresponding to a selected object;
processing the request at a session manager; and

Serial No. 09/604,835

8

transmitting a control message from the session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth, said transport stream generator transmitting said video sequence if sufficient bandwidth is available, said transmitted video segment adapted for presentation at said requested terminal, and including a beginning portion of said video segment. (Emphasis added).

The Applicants' method monitors available bandwidth and allows a user to view a requested video segment from the beginning if there is available bandwidth. Specifically, a session control manager receives a request for a video segment. One of the functions performed by the session manager is the transmission of control messages. In response to the request for the video segment, the session manager sends a control message to a transport stream generator. The control message indicates whether a transport stream may be discontinued by the transport stream generator to release bandwidth. If there is available bandwidth, the transport stream generator transmits the requested program to a set top terminal.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983) (emphasis added)). The Girard reference fails to disclose each and every element of the claimed invention, as arranged in the claim 1.

Girard fails to disclose the "transmission of a control message from the session manager to a transport stream generator, where the control message causes the transport stream generator to discontinue a transport stream and to release bandwidth so that another transport stream may be transmitted by the transport stream generator, as recited in Applicants' claim 1. Therefore, for at least the reasons discussed above, each and every element of the claimed invention, arranged as in claim 1, is not taught or even suggested by Girard.

As such, the Applicants submit that independent claim 1 is not anticipated under 35 U.S.C. §102 and is fully patentable thereunder. Furthermore, claims 2-4 and 6 depend, either directly or indirectly, from independent claim 1 and recite additional limitations thereof. As such and for at least the same reasons, the

Serial No. 09/604,835

9

applicants submit that these dependent claims are not anticipated under 35 U.S.C. §102 and are fully patentable thereunder. Therefore, the Applicants respectfully request that the rejections be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a)

The Examiner has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Girard in view of Hendricks et al. U.S. Patent 5,559,549 ("Hendricks"); claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Girard; and claims 9-13 under 35 U.S.C. §103(a) as being unpatentable over Girard in view of Aharoni et al. U.S. Patent No. 6,014,694 ("Aharoni"). Applicants traverse the rejection.

A. Claim 5

The Examiner has rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Girard in view of Hendricks. Applicants traverse the rejection.

The explanation given of Girard with respect to the §102 rejection is also applicable with respect to the §103 rejection herein. As such, and for brevity, that explanation will not be repeated in as great detail. As indicated, Girard does not teach or suggest "transmitting a control message from the session manager to a transport stream generator, said control message indicating whether a transport stream may be discontinued by said transport stream generator to release bandwidth, said transport stream generator transmitting said video sequence if sufficient bandwidth is available, said transmitted video segment adapted for presentation at said requested terminal, and including a beginning portion of said video segment," as recited in Applicants' claim 1. Because Applicants' claim 5 depends from claim 1, claim 5 also contains the features (the features of claim 1) not taught or suggested by Girard.

The addition of Hendricks does not correct the deficiencies of Girard. Hendricks discloses a digital television program delivery system that provides subscribers with a menu-driven access to an expanded television program package. The system allows for a number of television signals to be transmitted by using digital compression techniques. However, Hendricks is also silent with respect to the

Serial No. 09/604,835

10

transmission of a control message by the session control manager, as recited in Applicants' claim 1.

For prior art references to be combined to render obvious a subsequent invention under 35 U.S.C. §103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Unroyal v. Rudkin-Wiley, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message sent from the session manager to the transport stream generator which allocates available bandwidth.

Therefore, the combined references fail to teach the Applicants' invention as a whole. As such, the applicants submit that claim 5 (at least for its dependency upon non-obvious independent claim 1) is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

B. Claims 7 and 8

The Examiner has rejected claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Girard. Applicants traverse the rejection.

The comments previously made herein with respect to Girard are also applicable in this section. As such, and for brevity, those comments will not be repeated. As indicated above, Girard does not render Applicants' claim 1 obvious. In addition Applicants' claims 7 and 8 depend (either directly or indirectly) from claim 1 and recite additional features therefore.

Applicants respectfully submit that at least for its dependency upon claim 1, claims 7 and 8 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103 rejection.

Serial No. 09/604,835

11

C. Claims 9-13

The Examiner has rejected claims 9-14 under 35 U.S.C. §103(a) as being unpatentable over Girard in view of Aharoni et al. U.S. Patent No. 6,014,694 (Aharoni). Applicants traverse the rejection. Applicants direct the Examiner's attention to the fact that at paragraph 7 of the Office action, the Examiner indicated that claims 9-13 were rejected. Applicants also note that on page 7 of the Office action that the Examiner indicated that claim 14 is also rejected. Applicants interpret the rejection of "claims 9-13" as a typographical error which should read "claims 9-14."

The comments previously made herein with respect to Girard are also applicable in this section. As such, and for brevity, those comments will not be repeated.

The addition of Aharoni does not correct the deficiencies of Girard. Aharoni discloses transporting video over networks wherein the available bandwidth varies with time. Specifically,

[t]he system comprises a video/audio codec that functions to compress, code, decode and decompress video streams that are transmitted over networks having available bandwidths that vary with time and location. Depending on channel bandwidth, the system adjusts the compression ratio to accommodate a plurality of bandwidths ranging from 20 Kbps for POTS to several Mbps for switched LAN and ATM environments. See Aharoni Abstract.

However, Aharoni is also silent with respect to the "transmission of a control message from the session manager, as recited in Applicants' claim 1. Nowhere in the combination of references is there any teaching, suggestion, or incentive to include a control message from the session manager to the transport stream generator indicating whether a transport stream may be discontinued by the transport stream generator.

Therefore, the combined references fail to teach the Applicants' invention as a whole. As indicated above, Girard or Aharoni do not render Applicants' claim 1 obvious. In addition Applicants' claims 9-14 depend (either directly or indirectly) from claim 1 and recite additional features therefore. As such, the Applicants submit that

Serial No. 09/604,835

12

claims 9-13 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Thus, the Applicants submit that all the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Frank Tolin, Esq. or Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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